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EXAMINER

WALSH, BRIAN D

ART UNIT PAPER NUMBER

3722

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/922,938
Filing Date: August 07, 2001
Appellant(s): WIRTH ET AL.

Michelle N. Lester
For Appellant

EXAMINER'S ANSWER

MAILED
APR 07 2004
GROUP 3700

This is in response to the appeal brief filed 24 February 2004, part of paper no. 14.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The statement of the status of the claims contained in the brief is correct.

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Applicant's statement regarding the grouping of claims is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

0,114,670	Gray, George A., Jr.	05-1871
5,186,087	McCormack	02-1993
6,000,447	Clay	12-1999
6,178,856	Caddaye et al.	01-2001
2,700,912	Hardy, P.S.	04-1950
3,065,581	Lebermann	11-1961

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 12 is rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 12, pages 3 – 4.

Claims 14, 16, 18 and 19 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 12, pages 4 – 6.

Claim 15 is rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 12, pages 6 – 7.

Claim 20 is rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 12, pages 2 – 3.

Claim 21 is rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 12, page 7.

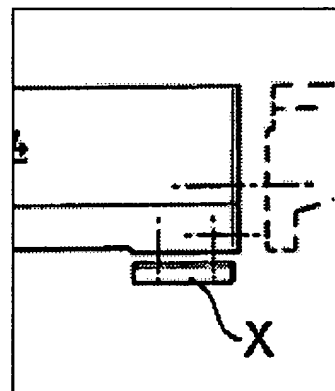
(11) Response to Argument

A. Claim 12 is not obvious from McCormack in view of Gray.

Appellant notes that the Examiner acknowledges McCormack fails to disclose modular bed units on either or both sides of a headstock in a lathe apparatus and that the Examiner then cites Gray as a secondary reference to provide support that it would be obvious to one of ordinary skill in the art to provide these modules on either side of the bed.

Appellant argues (bottom of page 6, continuing into page 7) that McCormack fails to teach or suggest a headstock base could or should be replicated in either direction (presumably either longitudinal direction) nor does McCormack teach or suggest that a motor assembly supporting the headstock base could or should be duplicated in either direction.

The Examiner agrees with this statement since McCormack certainly does not show multiple headstock bases nor multiple motor assemblies supporting multiple headstock bases. Claim 12, nor any embodiment in the instant invention require this feature. Furthermore, the Examiner did not make this argument in the rejection and considers the statement moot with respect to claim 12. Appellant then argues (line 4, page 7) that McCormack fails to disclose a second base unit. The Examiner draws Appellant's attention to a feature shown in figure 1 of McCormack which is not labeled or discussed in McCormack, but is labeled here at the right (X).



The Examiner deems that while this element is not disclosed, one of ordinary skill in the art would clearly determine it to be a leg, footing, support or, in the instant case, a second base unit. A lower surface of the bed even includes a step-

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portion above supposed base unit (X) to meet this feature. Cantilever-style beds are known in the art, but not known to be used when a frame includes, as McCormack discloses, three separate attachments to the side of the main headstock unit. Deflection in such a configuration would be tremendous. Having considered these aspects, the Examiner still deemed it proper to supply one of the multitude of prior art references available that teach a secondary base unit or footing in a lathe bed. For this, the Examiner selected Gray (U.S. Pat. No. 0,114,670). Gray was chosen for a number of reasons since it includes features similar to the overall inventive concept of the instant invention. For instance, Gray includes multiple, sliding tailstocks and workpieces supported on either side of the headstock. Gray shows two separate footings, or base units (not labeled, but clear in figure 1) and teaches their use as part of a device to provide accurate work.

Appellant next argues that the device of Gray is not centrally supported (page 7, paragraph 3) and asserts that Gray is not modular in construction. While the Examiner does not agree with this argument, it is considered moot since Gray was not relied upon for these elements. Furthermore, central support for the lathe bed is not a claimed limitation.

B. Claim 15 is not obvious from Hardy in view of McCormack in view of Gray and/or Lebermann.

The Examiner notes that Appellant chose the heading "Claim 15 is not obvious from Hardy in view of McCormack in view of Gray **and/or** Lebermann." The Examiner has rechecked the rejection and confirmed that the rejection was stated as each respective reference 'in view of' another.

Appellant next contests the Examiner's motivation to combine (page 8, paragraph 3) said references and indicates that the references fail to show a teaching or suggestion to do so. The

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Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ 114; *In re McLaughlin*, 170 USPQ 209. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545.

Regarding Appellant's assertion that the Examiner engaged in "picking and choosing" from the prior art only to the extent that it will support a holding of obviousness while excluding essential elements, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that McCormack fails to provide a teaching that would inspire one of ordinary skill in the art to make the seemingly unitary body of Hardy out of modular units (page 9, paragraph 1). Appellant's language of "attaching a second bed" to Hardy doesn't seem beneficial at all. However, McCormack teaches the benefit of modular lathe bed construction, not simply "attaching a second bed." In improving previous designs, an ordinary artisan would consider the lathe bed as an area of possible improvement. McCormack illustrates how that modification would not only be beneficial, but would now also be obvious.

Appellant further notes that the Examiner acknowledges that Hardy and McCormack do not teach spring biased pins for indexing as required by claim 15 (page 9, paragraphs 2 and 3).

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Indexing mechanisms are notoriously well known in the art of turning (lathes). Hardy and Lebermann both show indexing mechanisms for the same. Hardy relies upon an indexing mechanism that includes a threaded fastener (60) while Lebermann relies upon a spring-biased pin (110, 111, figure 5, top right portion of the device). Their function, intended use and environment are identical in every way. The Examiner asserts that looking to identical art in the same field for elements that perform the same function on devices that operate in the same manner and making a proper combination based on those teachings is certainly not hindsight reconstruction. Given that the elements are so well known in the art, selecting between a threaded fastener and a spring-biased pin for an indexing device is a simple design choice that provides a faster method for releasing the indexing mechanism as is clearly taught by Lebermann.

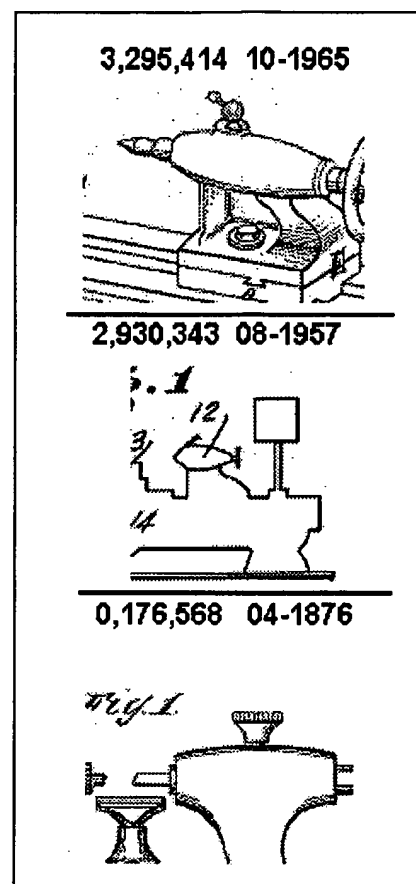
Appellant next asserts that the combination of Hardy and Lebermann is improper because it would destroy the workability of Hardy's invention (paragraph 3, page 10 – paragraph 2, page 11). The Examiner disagrees. Lebermann is silent with respect to the number of increments that can be attained by the biased pin (Lebermann, col. 5, lines 54 – 73) and since illustrations are not necessarily drawn to scale it is conceivable that the pin (111) and notches (107) of the disk are sufficiently small to allow for very minute adjustments of the indexing disk. Hardy also explains that his system is not without flaws with respect to the actual accuracy of the device and states that the engaging disk surface and fastener have to be kept smooth and made from proper materials to reduce angular displacement (col. 3, lines 20 – 27). Hardy is silent with how much of an angular displacement may occur when the fastener is activated. The result is that neither device is capable of providing an absolute degree of accuracy.

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Appellant's remark that the tailstock is unique in its ergonomic and aesthetically pleasing assembly (page 12, end of paragraph 2) is refuted by the Examiner, who quickly located numerous references showing nearly identical construction (see figure to the right). The shape of the tailstock is purely a matter of design choice, however, the Examiner provided readily available reference Hardy to illustrate a tailstock with a generally elliptical shape and generally circular cross section.

C. Claims 14, 16, 18 and 19 are patentable over McCormack in view of Caddaye in view of Hardy.

Appellant argues that Hardy predates McCormack by over 35 years. This statement, in and of itself, provides no argument discernable to the Examiner. The Examiner assumes that Appellant was intending to imply that the combination of these two elements is inappropriate due to simple difference in patent dates. However, this is inconsistent with the remainder of the Brief since Appellant failed to mention the age of the Gray (1871) reference in the arguments pertaining to claim 15, which predates Lebermann and McCormack by 90 and 122 years, respectively. Regardless, contentions that the reference patents are old is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references or that the difference in age of the patents somehow restricts one reference from teaching the other. See *In re Neal*, 481 F.2d 1346, 179 USPQ 56.



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Appellant further argues that the tailstock of Hardy is improperly modified to be slidable. In opposition to Appellant's statement, the fact that Hardy fails to disclose a slidable tailstock (and all other components for that matter) is the exact motivation for such a modification. An ordinary artisan in the art of turning is so accustomed to seeing slides and carriages on modern lathes that the absence of such a feature is a rarity. Hardy's invention is not drawn to bed features, rather the indexable nature of the headstock. Therefore, it is conceivable that in order to please the Office and facilitate prosecution, Hardy did not disclose every conceivable feature applicable to the invention, knowing that such a modification is purely obvious to those with even minimal skill in the art. However, Caddaye, not Hardy, was relied upon to show the well known feature of slidable tailstocks. Hardy was relied upon solely for the elliptical shape of the tailstock.

The elements of claim 18 that are argued (page 12, paragraph 3 – page 13, paragraph 1) involve the location of a second base unit and are discussed above in dealing with claim 12 (first section under response to arguments).

D. Claim 20 is not anticipated by Clay (2nd heading "C" by Appellant).

Appellant's main argument is that the instant invention includes a slider block and a non-circular locking shaft that extends longitudinally of the housing and is disposed through a bore in the slider block. As far as the Examiner can determine, the only functional difference between Clay and that which is claimed in claim 20 is the names given to the individual features in the inventions. The Examiner compares figure 4 (taken along IV-IV in figure 1) of Clay with figures 23 and 24 of the instant invention. Appellants argument that Clay does not teach a slider block having a bore. The "slider block" is viewed as the combination of elements 12 and 13 in

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Clay, the bore is clearly shown between element 15 and 13 in figure 4. Whereas Clay provided a slider block comprised of more than one piece, Appellant has chosen a unitary construction. The Examiner notes that Appellant did not claim the slider block to be of single, unitary construction.

E. Claims 21 is not anticipated by Hardy in view of McCormack and further in view of Clay (heading D by Appellant).

As noted above, the Examiner has determined that providing slides and carriages on a lathe bed is notoriously well known in the art and does not require hindsight reconstruction. Modification of Hardy to include these features would be an obvious decision by those of ordinary skill in the art.

Regarding the bore in the slider block of Clay, Appellant clearly states that the cam (13 – 15) is rotatably disposed. However, only element (13) is the cam, not element (15). (15) is a “bearing element.” The bore is situated within cam (13), which element (15) is rotatably disposed therein. Therefore, in order for the cam to rotate it must be situated in a bore.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



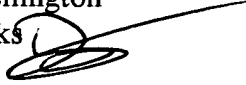
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April 2, 2004

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